

REMARKS

Claims 1-4 and 6-21 are currently pending in the application. By this amendment, claim 3 is amended and claim 21 is added for the Examiner's consideration. The above amendments do not add new matter to the application and are fully supported by the specification. For example, support for new claim 21 is provided at page 10 of the specification. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

35 U.S.C. §102(b) Rejection

Claims 1-4 and 6-20 (incorrectly indicated by the Examiner as claims 1-20) are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No.: 6,061,660 to EGGLESTON, et al. ("EGGLESTON"). This rejection is respectfully traversed.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, a single prior art reference must disclose each and every element as set forth in the subject claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that a *prima facie* case of anticipation cannot be established because EGGLESTON fails to teach each and every element of the claims.

In particular, independent claims 1, 2, 7, 11, 12 and 17 recite, *inter alia*, checking a database of promotions for presence of a promotion that includes the qualifying value.

Furthermore, independent claim 1 recites, *inter alia*, when a promotion that includes the qualifying value is present in the database, associating the qualifying value of the promotion with a module of selectively executable compiled web server code residing on a server's body of compiled code, selecting the module of selectively executable compiled web server code

and executing the module of selectively executable compiled web server code that provides the promotion,
wherein the associating is made explicitly by pointers that are included in terms of the promotions.

Furthermore, independent claim 2 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, determining a reward value of the promotion that includes the qualifying value based on associating a module of selectively executable compiled web server code residing on a server's body of compiled code made explicitly by pointers that are included in terms of the promotion; and
executing the module of selectively executable compiled code associated with the reward.

Additionally, independent claim 7 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, determining whether the promotion that includes the qualifying value is active; and

when the promotion that includes the qualifying value is active, determining a reward value of the promotion that includes the qualifying value and executing a module of selectively executable compiled code associated with the reward value.

Also, independent claim 11 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, executing a module of selectively executable compiled web server code that provides the promotion.

Moreover, independent claim 12 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, determining a reward value of the promotion that includes the qualifying value; and executing a module of selectively executable compiled code associated with the reward value.

Finally, independent claim 17 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, determining whether the promotion that includes the qualifying value is active; and when the promotion that includes the qualifying value is active, determining a reward value of the promotion that includes the qualifying value and executing a

module of selectively executable compiled code associated with the reward value.

Applicants submit that EGGLESTON does not disclose, or even suggest, at least these features. Applicants acknowledge, for example, that EGGLESTON discloses a system which utilizes client computers 34 which are equipped with browsers 50 allowing users to access a host computer 18 (see col. 9, line 66 to col. 10, line 54). Applicants also acknowledge that the disclosed system allows a user, who has properly registered as a member of the host incentive program system, to access and search information in an incentive program (see col. 12, lines 19-57). Finally, Applicants acknowledge that EGGLESTON discloses at col. 13, lines 3-6 that “[c]onsumer participation in incentive programs results in the automatic updating of the consumer database 200 and the sponsor database 202, which contain such information in records associated with the consumer.” However, it is clear that this document does not specifically disclose or suggest checking a database of promotions for presence of a promotion that includes the qualifying value. Nor has the Examiner identified any disclosure in EGGLESTON which even remotely discloses or suggests this feature.

Moreover, while the Examiner has alleged that EGGLESTON discloses this feature at col. 40, lines 7-24 and col. 44, lines 5-63, it is clear from a fair reading of this language that EGGLESTON does not disclose or suggest checking a database of promotions for presence of a promotion that includes the qualifying value.

Applicants emphasize that col. 40, lines 7-24 of EGGLESTON merely states as follows:

An embodiment of the present invention would include a retail-based information management and inventory system that consists of data communications equipment and a central server based on open systems technology. The server would perform gateway switching to outside third parties (such as credit card issuers or fulfillment card issuers, check verification services, EDI services, and the like) as well as enterprise users (host, server or client-based users) for in-house applications, including those that access customer databases. The inventory system in question would be enterprise-wide and would allow for the basic inventory tracking (stock keeping unit, SKU, availability) and replenishment applications as well as newer consumer purchasing pattern databases. The central server could perform gateway switching to outside third parties including credit card or check authorization as well as electronic fulfillment companies.

Applicants also emphasize that col. 44, lines 5-63 of EGGLESTON merely states

as follows:

Next, the consumer receives instructions at a step 552 to visit a retail store, and the consumer presents the card 11 at a point-of-sale terminal at a step 554. When the card is scanned, the retail system software locates and confirms that the consumer is a pre-registered fulfillment card customer at a step 558. Then it checks to match any item (product or service) that was scanned via the point of sale terminal with the pre-paid item in their consumer database record at a step 560. If the consumer does not appear in the database, then a check is made of the input at a step 562. If the input was correct, but the item was not found, the consumer is referred to the issuer at a step 564. If the consumer is registered as a winner, then the consumer presents the card 11 for the given promotion at a step 568. The system then identifies the prize in the retailer inventory system 212 at a step 570. A query is made to the winner's file at a step 572 to match the prize to the winner. At a step 574 a check is made to determine if the award is at the point of sale. If at a step 576 the award is available, the consumer is notified at a step 578 and the consumer is given the prize. If the award is not available at the step 576, the system checks for an equivalent substitute at a step 580. If no equivalent is available, the consumer is referred to the issuer at a step 582. Otherwise, the consumer is provided a substitute at a step 584. If the award is available, or a substitute is available, then the retailer credits the consumer's bill for the amount of the award or applies a discount at a step 586. The consumer receives an authorization code on a receipt at a step 588. The consumer may then exit with the award at a step 590. If the item has been presented by the time of the total, the system deducts full amount for prize won or applies a discount as appropriate. The winner's file has the specification. The winner's file is a consumer database record and indicates the availability of in-store credit for a particular item or items or a discount.

If the consumer is a winner, but failed to retrieve the winning item, the transaction printout will provide the note for the product to be retrieved. The fulfilled transactions data, including the incentive firm ID, number of the persons, the name of the persons, and products or services won will be collected at a step 592 and uploaded at a step 594 periodically via a batch file to the incentive firm via the issuer for remittance of funds, less any transaction costs as contracted. The incentive firm may then confirm the award at a step 596 and fulfill funds to the retailer at a step 598.

The same can be accomplished with varying degrees of merchant sophistication, including single store merchants with manual inventory tracking procedures. The system for a less sophisticated merchant may be seen in a flow chart 600 at FIG. 26. When the consumer wins at a step 602, a data entry is created in a winner's table at a step 604 in the consumer database and the winner's table is updated online at a step 606. In the case of these less sophisticated merchants, upon presentation of an item at check-out they would be able to access the award database by dedicated line dial-up, or phone call, and after imputing the store's password, would have online access to a winner's file that have items to redeem in their store as well as the card numbers and individuals that have won the information.

Applicants are unable to see the relevancy of the former language to the feature asserted to be disclosed thereby. Moreover, while it is true that the latter language discusses a system which can check whether a purchased item is a pre-paid item in a consumer database, the Examiner is not correct that this language discloses checking a database of promotions for presence of a promotion that includes the qualifying value. There is simply no equivalency between such language and the recited feature.

It is also clear that EGGLESTON is entirely silent with regard to when a promotion that includes the qualifying value is present in the database, associating the qualifying value of the promotion with a module of selectively executable compiled web server code residing on a server's body of compiled code, selecting the module of selectively executable compiled web server code and executing the module of selectively executable compiled web server code that provides the promotion, wherein

the associating is made explicitly by pointers that are included in terms of the promotions. Nor has the Examiner identified any disclosure in EGGLESTON which discloses or suggests any of these features. For example, while the Examiner has identified col. 34, lines 1-20, as disclosing pointers which are included in terms of the promotions, it is clear from a fair reading of the cited language that it merely discloses that a pointer may be clicked on a particular scratch-and-win game.

Additionally, EGGLESTON is also entirely silent with regard to when a promotion that includes the qualifying value is present in the database, determining a reward value of the promotion that includes the qualifying value based on associating a module of selectively executable compiled web server code residing on a server's body of compiled code made explicitly by pointers that are included in terms of the promotion and executing the module of selectively executable compiled code associated with the reward. Again, the Examiner has clearly failed to identify any disclosure in EGGLESTON which discloses or suggests any of these features.

EGGLESTON is also entirely silent with regard to when a promotion that includes the qualifying value is present in the database, determining whether the promotion that includes the qualifying value is active and when the promotion that includes the qualifying value is active, determining a reward value of the promotion that includes the qualifying value and executing a module of selectively executable compiled code associated with the reward value. Again, the Examiner has clearly failed to identify any disclosure in EGGLESTON which discloses or suggests any of these features.

EGGLESTON is additionally entirely silent with regard to when a promotion that includes the qualifying value is present in the database, executing a module of selectively executable compiled web server code that provides the promotion. Again, the Examiner has clearly failed to identify any disclosure in EGGLESTON which discloses or suggests any of these features.

EGGLESTON is additionally also entirely silent with regard to when a promotion that includes the qualifying value is present in the database, determining a reward value of the promotion that includes the qualifying value and executing a module of selectively executable compiled code associated with the reward value. Again, the Examiner has clearly failed to identify any disclosure in EGGLESTON which discloses or suggests any of these features.

Finally, EGGLESTON is also entirely silent with regard to when a promotion that includes the qualifying value is present in the database, determining whether the promotion that includes the qualifying value is active and when the promotion that includes the qualifying value is active, determining a reward value of the promotion that includes the qualifying value and executing a module of selectively executable compiled code associated with the reward value. Again, the Examiner has clearly failed to identify any disclosure in EGGLESTON which discloses or suggests any of these features.

Thus, Applicants respectfully submit that independent claims 1, 2, 7, 11, 12 and 17 and dependent claims 3, 4, 6, 8-10, 13-20, are allowable.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 102(e) should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to **IBM Deposit Account No. 09-0457** (Endicott).

Respectfully submitted,
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